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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,571	07/21/2003	Masaru Iriya	0071-0528P	4799
2292	7590	09/03/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NOLAN, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/622,571	Applicant(s) IRIYA ET AL.	
	Examiner Sandra M. Nolan	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-21-03 + 9-17-03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims

1. Claims 1-7 are pending.

Information Disclosure Statement

2. The information disclosure statements (IDS's) submitted on 21 July 2003 and 17 September considered by the examiner.

Citations for which no English abstract/translation or statement of relevance were provided have been crossed off of the citation lists, where appropriate.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is "D-body"?

Please clarify the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Topolkaraev et al (US 6,660,211) in view of Shibata et al (US 2002/0102423A1).

Topolkaraev teaches films made of polylactic acid (col. 4, lines 7) containing 5 to 40% (col. 8, line 9) of a glycerol triacetate (col. 7, line 60).

It fails to teach the physical properties recited in claim 1.

Shibata teaches wrap films that are packaged in boxes with cores, like SARAN WRAP™ (page 12, par. 0163), which films have surface roughness of less than 0.078 μm (page 9, par 0126) and excellent winding properties (page 14, par. 0169).

The references are analogous because they both deal with films.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ Shibata's properties when formulating/making films based on the compositions of Topolkaraev.

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The motivation to employ the Shibata properties when formulating/making films based on the compositions of Topolkaraev is found at page 14, par. 0169 of Shibata, where excellent winding properties are discussed.

It is deemed desirable to make films having good winding properties so that the films will be easy for consumers to use.

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Kuroki et al (EP 1029890A2).

The European publication was cited by applicants.

Shibata is discussed above.

It fails to teach PLA films containing glyceryl ester additives.

Kuroki teaches PLA wrapping films (page 3, pars. 0013 and 0015) containing 10-60% glyceryl ester additive (page 4, par. 0023), with 80% of the additive being the ester (A), which meets the limitations of applicants' claim 5. The films are biodegradable (page 2, par. 0001).

The references are analogous because they both deal with wrapping films.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the compositions of Kuroki to make the films of Shibata in order to make its films biodegradable.

The motivation to employ the compositions of Kuroki to make the films of Shibata is found at page 2, par. 0001 of Kuroki, where the biodegradability of its films is taught.

It is deemed desirable to make films that are biodegradable in order to preserve the environment.

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9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata and Kuroki as applied to claims 1-5 above, and further in view of JP 05-162747 (based on its English abstract).

The Japanese publication was cited by applicants.

Shibata and Kuroki are discussed above. They fail to teach the paper cutter of claims 6-7.

JP 05-162747 teaches paper cutters on boxes for cartons for packaging sheets. Note the Purpose section, where the disposability of the paper cutter is discussed.

The examiner interprets "packing sheet" in the abstract to mean packaging sheet.

The three references are analogous because they all deal with packaging materials.

It would have been obvious to one having ordinary skill in the art to employ the paper cutters of the Japanese publication on the boxes of the products suggested by the combination of Shibata and Kuroki, above.

The motivation to employ the paper cutters of JP 05-162747 on the boxes of the products suggested by the combination of Shibata and Kuroki is found in the Purpose section of the abstract, where the disposability of the paper cutter is discussed.

It is deemed desirable to make boxed wrapping films that employ disposable cutters in order to make the product as biodegradable/disposable as possible.

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Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan
Primary Examiner
Technology Center 1700

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